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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,907	07/11/2001	Veronique Guillou	210231US0	7859

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/901,907

Applicant(s)

GUILLOU ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment and Declaration filed on March 19, 2002. Claims 1-23 are pending. A new claim rejection is made under 35 U.S.C. § 103 to include new claim(s) added by applicants, however, the substance of the previous rejections as indicated in the office action dated December 19, 2002, is otherwise maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is vague and indefinite as one of ordinary skill in the art would have not readily viewed "sugars" are as a solvent. While applicants amended the recitation of claim 17, "sugar" is still referred as a solvent component.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1- 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukenbach (US 6090773) ("Lukenbach") in view of Derian et al. (US6262130 B1) ("Derian").

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Lukenbach teaches a conditioning shampoo or body cleanser composition comprising cationic polymers, an amphoteric surfactant, anionic surfactant, and a nonionic surfactant. See col. 1, line 34 – col. 2, line 59. See instant claims 19-22. Amphoteric and anionic phosphate surfactants are disclosed in col. 6, line 56 – col. 10, line 46. Nonionic surfactants such as alkylpolyglucosides are mentioned. See col. 4, lines 52 – 63. The cationic polymers suitable for the invention include polyquaternium-7, meeting instant claims 12, 13, 16, and 23. See col. 10, line 57 – col. 12, line 37. The reference lacks the teaching of the specific phosphate surfactants of the instant claims 4 and 16.

Derian teaches aqueous surfactants comprising alkyl phosphate ester salts useful in formulating flowable or pumpable transparent gels. See abstract; col. 1, line 19 – col. 2, line 55. Potassium salt of dodecyl phosphate is disclosed. See instant claims 4 and 16. The reference teaches that the alkyl phosphate ester salts are useful in cosmetic and personal care products because of their foaming properties, detergency, non-irritating properties, form density, stability and skin feel. The invention, which is pumpable and transparent, is also said to allow minimize the amount of co-solvents or other surfactants. See col. 3, line 10 – col. 4, line 44. Although both references are silent as to the measurement of the actual foam height of the inventions, examiner takes the position that, in view of the fact that prior art which meet the limitations of the instant claims, the claimed properties of the instant inventions may be due to the limitations not disclosed in the instant claims.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Lukenbach by substituting the phosphate surfactants with the phosphate surfactants of Derian because of the expectation of successfully producing a transparent cleansing composition with good foaming properties, detergency, non-irritating properties while minimizing the need of other ingredients.

Response to Arguments

Applicant's arguments filed March 19, 2002 have been fully considered but they are not persuasive.

Applicants distinguish Lukenbach from the present invention by asserting that the prior art is directed to an opaque or pearlescent hair composition containing components not claimed by applicants. Examiner respectfully disagrees with the applicants' arguments. It is noted that instant claims are directed to "cleansing composition" for skin, scalp, and/or hair. See instant claims 19-22. As indicated in the previous office action, Lukenbach teaches that the invention therein is applicable to either shampoo or body cleansing formulation. See col. 1, line 34 – col. 2, line 59. Also, the transitional phrase recited comprising in the instant claims does not necessarily exclude additional components not recited in therein. See MPEP § 2111.03. Thus, the presence of the additional surfactants or hair conditioning components in Lukenbach's composition does not necessarily negate the teaching or suggestion of the instant invention as claimed. Furthermore, examiner views that the opacity of Lukenbach's composition alone is not sufficient to overcome the obviousness

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rejection in this case, since one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Derian is cited to show that anionic phosphate surfactants are used in personal cleansing formula to produce transparent foaming gel. Nothing nonobvious is shown in combining well-known components in a conventional formulation. See MPEP § 718.02.

Applicants also argue that Lukenbach does not teach or suggest a skilled artisan to select applicants' preferred embodiment. It is well established in patent law that patents are relevant as prior art for all they contain. See MPEP § 2123. The court in Merck & Co. v. Biocraft Laboratories held that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. See 874 F.2d 804, 10 U.S.P.Q. 2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). Furthermore, even nonpreferred embodiments constitute a prior art. See In re Susi, 440 F.2d 442, 169 U.S.P.Q. 423 (C.C.P.A. 1971). In this case, applicants assert that Lukenbach prefers, among others, a saccharide-containing cationic polymer which applicants seek to exclude from their invention (i.e., polyquaternium-10). However, applicants' argument is not persuasive because the prior art also teaches an alternatively preferred cationic polymer which is employed by the present invention (i.e., polyquaternium-7). Examiner views that it would have been obvious to a skilled artisan to choose one cationic polymer over another, given the teaching that both are preferred conditioning agents used in personal cleansing art.

Although through Declaration filed March 19, 2002, applicants seek to demonstrate the superior results of polyquarternium-7 over polyquarernium-10, given the general teaching that both of these well-known polymers are comparable and suitable for the same conventional use, choosing one over the other is viewed as a mere preference by a skilled artisan and not a nonobvious choice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951. The examiner can normally be reached on Monday-Friday, 8:30 am - 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
June 1, 2002


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